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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEAN-LUC COLLET, FRANCOIS-XAVIER DROUET,  
GERARD MARMIGERE, and JOAQUIN PICON

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Appeal 2009-007318  
Application 10/822,432<sup>1</sup>  
Technology Center 2400

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Before JEAN R. HOMERE, CAROLYN D. THOMAS, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>2</sup>

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<sup>1</sup> Filed on April 12, 2004. This application claims foreign priority to application 03368043.0, filed on April 29, 2003. The real party in interest is International Business Machines Corp. (Br. 1.)

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 16. (Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

### *Appellants' Invention*

Appellants invented a system and method for cancelling an email forwarded by a sender to a plurality of recipients only when none of the recipients has read the email. (Spec. 3, l. 30-*id.* at 4, l. 2.)

### *Illustrative Claim*

Independent claim 1 further illustrates the invention as follows:

1. System for enabling the cancellation of a previously-sent e-mail, comprising a data transmission network, wherein a plurality of users are connected to said network, each of said users being able as a sender to send an e-mail over said network to a plurality of users as recipients connected to said network, and wherein a message transfer agent (MTA) is associated with each of said users for sending the e-mail when said user acts as a sender and delivering the e-mail when said user acts as a recipient,

wherein each MTA includes a cancel mailbox for transmitting a cancellation message to said recipients when the user associated with said MTA is a sender wanting to cancel a previously-sent e-mail or for managing the cancellation of e-mails in the mailbox of the user associated with said MTA upon receiving said cancellation message from said sender when this user is a recipient,

wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said e-mail.

*Prior Art Relied Upon*

The Examiner relies on the following prior art as evidence of unpatentability:

Nielson	5,870,548	Feb. 9, 1999
Leonard	6,721,784 B1	Apr. 13, 2004
		(filed Dec. 30, 1999)

*Rejection on Appeal*

The Examiner rejects claims 1 through 16 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Nielson and Leonard.

*Appellants' Contentions*

Appellants contend that Nielson discloses deleting an email on a recipient-by-recipient basis, irrespective of the reading actions of other recipients, whereas the claimed invention is directed to deleting a previously sent email only if none of the recipients has read the email. (Br. 4-5.) Appellants also argue that Leonard's disclosure of a sender deleting a previously sent email completely independent of the actions taken by any of the recipients of the email, does not teach an MTA that is configured to "cancel the e-mail sent to the recipient only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said e-mail," as recited in independent claim 1. (*Id.* at 5.) Additionally, Appellants allege that Leonard's disclosure of a separate "oops" button for cancelling an email is performed irrespective of the read status of the email. (*Id.* at 6.) Further, Appellants contend that although Leonard discloses tracking the status of emails, Leonard fails to disclose the selective cancellation of an email "only when none of the recipients has read the email," as recited in independent claim 1. (*Id.*)

*Examiner's Findings and Conclusions*

The Examiner finds that Nielson discloses that a “cancel message” is an email message that “is constructed to cause the recipient’s email system to delete a previously-sent message that the recipient has not seen, or to notify the recipient of the sender’s desire to cancel the previously-sent email message that the recipient has seen.” (Ans. 15.) Therefore, the Examiner finds that Nielson’s disclosure teaches checking or tracking whether a previously sent email has been seen or read by a recipient, and depending on the corresponding status, deleting or processing the email accordingly. (*Id.* at 16.)

Further, the Examiner finds that Leonard also discloses tracking whether or not a previously sent email has been read at least once by a recipient. (*Id.* at 17.) Moreover, the Examiner finds that Leonard teaches an electronic mail system that tracks information pertaining to the usage and handling of emails by all recipients, including individuals and a group of recipients. (*Id.*) In particular, the Examiner finds that Leonard’s disclosure distinguishes between an individual recipient and a plurality of recipients, or a group of recipients. (*Id.* at 17-18.) In summary, the Examiner finds that Nielson’s disclosure of tracking and monitoring whether a recipient has already read or seen an email, in conjunction with Leonard’s disclosure of monitoring the status of a previously sent email according to the type of recipient associated with the email (i.e., a group of recipients), teaches the disputed limitation. (*Id.* at 18-19.) Additionally, the Examiner finds that an ordinarily skilled artisan would have appreciated adapting and logically implementing Nielson’s methodology, as detailed in figures 10a-b and 11a-b, for a group of recipients, as disclosed in Leonard. (*Id.* at 19.)

## II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Nielson and Leonard renders independent claim 1 unpatentable? In particular, the issue turns on whether the proffered combination teaches “wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said e-mail,” as recited in independent claim 1.

## III. FINDINGS OF FACT

The following Findings of Fact (“FF”) are shown by a preponderance of the evidence.

### *Nielson*

1. Nielson generally relates to electronic mail management systems and, in particular, to allowing the sender of an email to delete or modify the email after it has been sent. (Col. 1, ll. 7-11.)
2. Nielson discloses that a cancel message is an email that causes a recipient’s email system to delete a previously sent email that the recipient has not seen, or notify the recipient of the sender’s desire to cancel the previously sent email that the recipient has seen. (Col. 4, ll. 39-43.)
3. Nielson’s figure 2 depicts a plurality of computers that implement email processing via the Internet. (Col. 6, ll. 18-20.) In particular, Nielson discloses a sender’s computer (200) that saves a copy of an email in the sender’s outbox (204). (*Id.* at ll. 21-25.) Further, Nielson discloses that the Internet (205) routes the email to the recipient’s computer

(202), whereby the email receiver facility (207) stores the email in the recipient's inbox (208). (*Id.* at ll. 30-34.)

4. Nielson's figure 10A depicts how a receiving email system processes the receipt of a cancel message. (Col. 14, ll. 22-23.) In particular, Nielson discloses that processing depends on whether or not the recipient has seen the email (1011). (*Id.* at ll. 54-55.) If the recipient has not seen the email, Nielson discloses deleting the previously sent email from the inbox (1017). (*Id.* at ll. 55-59.) If the recipient has seen the email, Nielson discloses that the receiving email system informs the recipient that the email was cancelled (1013). (*Id.* at l. 65-col. 15, l. 1.) Upon informing the recipient that the email was cancelled (1013), Nielson discloses providing the recipient with a number of options including allowing the recipient to delete the original email, or treating the cancel message as a normal email. (Col. 15, ll. 1-5.)

*Leonard*

5. Leonard discloses an electronic mail system that enables the sender of an email to select a date, time, or event at which the email and all incarnations of the email self-destruct, including selecting processing and handling limitations. (Abst.)

6. Leonard discloses tracking the usage and handling of an email by all recipients, including any individual or group of recipients. (Col. 10, ll. 20-23.) Leonard disclose tracking who receives the mail, who forwards the email, who modifies the email, the email addresses of all the relevant entities, and the dates and times of all transactions pertaining to the forwarding and handling of the email. (*Id.* at ll. 24-28.)

#### IV. ANALYSIS

##### *Claim 1*

Independent claim 1 recites, in relevant part, “wherein the cancel mailbox of each MTA is configured to cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, and is configured to not delete the e-mail when any of said recipients has read said e-mail.”

As detailed in the Findings of Fact section above, Nielson discloses an electronic mail management system that allows the sender of an email to delete or modify the email after it has been sent. (FF 1.) In particular, Nielson discloses that the electronic mail management system utilizes a plurality of computers to implement email processing, including a sender computer that contains an email outbox and a recipient computer that contains an email inbox. (FF 3.) Further, Nielson discloses that the recipient computer is capable of processing a cancel message, whereby the processing depends on whether or not the recipient has seen or read an email. (FFs 2 & 4.) In particular, Nielson discloses that a cancel message is an email that causes a recipient’s computer to delete a previously sent email that the recipient has not read, or notify the recipient of the sender’s desire to cancel the previously sent email that the recipient has read. (*Id.*)

We find that Nielson’s disclosure teaches a plurality of computers that contain an electronic mailbox (i.e., inbox/outbox). We also find that Nielson’s disclosure teaches that each electronic mailbox determines whether an email has been seen or read by a recipient as follows: 1) if the recipient has not read the email, Nielson’s disclosure teaches deleting the email; and 2) if the recipient has read the email, Nielson’s disclosure teaches



not deleting the email, but rather simply notifying the recipient of the sender's desire to cancel the email.

Next, Leonard discloses an electronic mail system that enables the sender of an email to select an expiration time for the email, including processing and handling limitations. (FF 5.) In particular, Leonard discloses tracking the usage and handling of an email by a group of recipients. (FF 6.) We therefore find that Leonard's disclosure teaches monitoring or tracking an email sent to a group of recipients.

In summary, we find that an ordinarily skilled artisan would have readily appreciated that each of Nielson's electronic mailboxes is *capable of* utilizing Leonard's methodology to monitor or track an email sent to a group of recipients and, subsequently, determine whether the email has been read by at least one of the recipients. Moreover, we find that the ordinarily skilled artisan would have understood that each of Nielson's electronic mailboxes is also *capable of* deleting the email if none of the recipients has read the email, and not deleting the email if any of the recipients has read the email. Thus, we find that the combination of Nielson and Leonard teaches or fairly suggests the disputed limitation.

Alternatively, we note that the disputed claim limitation only requires "the cancel mailbox of each MTA... to be *configured to* cancel the e-mail sent to the recipients only when none of the recipients has read the e-mail, as well as to be *configured to* not delete the e-mail when any of said recipients has read said e-mail." (Claims App'x) (emphasis added.) We find that the cited recitation merely requires that the cancel mailbox of each MTA be capable of cancelling or not deleting the email without actually canceling or deleting the e-mail. This recitation is therefore a statement of intended use,

which is fully met by a prior art structure that is capable of performing the recited functions. A statement of intended use in an apparatus claim cannot distinguish over a prior art apparatus that discloses all the recited limitations and is capable of performing the recited function. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). We note that “[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although “[s]uch statements often . . . appear in the claim's preamble,” *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.* We are therefore satisfied that the proffered combination teaches or suggests an equivalent structure that is capable of cancelling an email sent to recipients only when none of the recipients have read the email, and capable of not deleting the email if at least one recipient has already read the email. (FFs 2, 4, & 6.) Thus, it follows that Appellants have not shown that the Examiner erred in concluding that the combination of Nielson and Leonard renders independent claim 1 unpatentable.

#### *Claims 2 through 16*

Appellants do not provide separate arguments for patentability with respect to independent claim 4, and dependent claims 2, 3, and 5 through 16. Therefore, we select independent claim 1 as representative of the cited claims. Consequently, Appellants have not shown error in the Examiner's rejection of independent claim 4, and dependent claims 2, 3, and 5 through 16, for the reasons set forth in our discussion of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## V. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1 through 16 as being unpatentable under 35 U.S.C. § 103(a).

## VI. DECISION

We affirm the Examiner's decision to reject claims 1 through 16.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Vsh

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